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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,442

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Dov L. Randall

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K&L Gates LLP

P.O. Box 1135

CHICAGO, IL 60690

EXAMINER

RENDON, CHRISTIAN E

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

05/14/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No. 10/657,442	Applicant(s) RANDALL ET AL.	
	Examiner CHRISTIAN E. RENDÓN	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12,14-21,23-31,33-40,42-51 and 53-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12,14-21,23-31,33-40,42-51 and 53-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to the amendment filed on 4/24/09 in which applicant amended claims 1, 4, 10, 18, 29, 37-38, 48, 56-58, 62, 66-67; responds to claim rejections. Claims 1-4, 6-12, 14-21, 23-31, 33-40, 42-51, 53-67 are still pending.

Claim Rejections - 35 USC § 103

Claims 1-4, 6-12, 14-21, 23-31, 33-40, 42-51, 53-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (US 2003/0036419 A1) in view of one having ordinary skill.

1. Regarding claims 1, 10, 18, 29, 37, 48, 56-58, 62 and 66-67, Baerlocher discloses a primary or triggered bonus or secondary game that randomly generates or **selects** a plurality of digits of an **award** (abstract) that is **greater than zero**. The game instructs the player to create a three digit award value using the activated digits (fig. 3b-c). Thus the range of possible **award values** or offers will consist of the **same number of digits**. The game presents a number of digits that are **statically associated with an offer component**, the box that outlines the value. The game machine's **processor is programmed** to randomly generate **offer components** or digits for activation (par. 10, lines 5-6). The **selection of an offer component for activation** causes the game to **display the award value** (fig. 3D) **associated with the activated component** in the form of a message **84** (par. 70, lines 4-5). A player **determines an offer based on the award value** that are determined from the **activation order of the offer components** (fig. 3D, 120) and all possible awards consist of the **same number of digits** (par. 10, lines 10-12). In other words, the art teaches the selection of the ten's digit awards a player ninety credits (fig. 3D). The player then selects another offer components for activation such as the hundred's digit. The displaying of 5 as the hundred's digit will cause the game to add 500 credits to the current award value (par. 70, lines 8-11). Therefore the prior art teaches the

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summation of the award values of all the awards associated with the activated offer components. At this point the player is given a choice to **accept or reject the offer** (par. 18, lines 1-3). The preferred embodiment of the game randomly decides on a modification method to apply on the award **when the player rejects the offer** (par. 19, lines 2-5). Therefore at least one **component modifier is selected and displayed** (fig. 9). Once the modification process is complete, a **new award is displayed and available to the player** (par. 114, lines 6-7) for acceptance or rejection. In addition the reference states providing a display device able to present visual images using mechanical wheels (par. 46, lines 5-9), thus teaching the use of **displaying the component modifiers through a mechanical wheel.**

2. The included modification methods that change the state of an offer component are scrambling the digits, regenerating the award, subtracting or adding a digit and multiplying an award (par. 19, lines 6-9). The subtraction of a digit is the only modification that **unselects** a number or **offer component based on the** number or **value of the component** (par. 22, lines 5-7), therefore it is viewed as a **modifier associated with a negative value** or effect because of the impact it creates is undesirable (par. 130, lines 6-10). Furthermore, the prior art discloses the newly displayed award (46) is the **summation of the currently active offer components** (40, 6) (fig. 12). The addition of a digit (par. 125, lines 11-12) will always increase the award and is highly desirable since the **modifier is associated with a positive value** or effect. Furthermore, the prior art discloses the newly displayed award (4165) is the **summation of the currently active offer components** (4000, 100, 60, 5) (fig. 11). In addition, add/subtract digit modifier are also viewed as **changing the status of an offer component based on the value (positive/negative) associated with the modifier**, as described in claims 18 and 29. As for the multiplication modifier (par. 135, lines 7-8), the game randomly selects a multiplicand and the previous offer is the multiplier. The value of a multiplicand ranges from a

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negative value to zero to a positive value therefore this modifier is able to produce **awards of positive or negative values using positive or negative component number modifiers**.

3. Thus the multiplication modifier is the only modifier that requires a value hence the association with a value (fig. 13). Therefore the prior art fails to teach two of the applicant's limitations: containing **only different modifying components associated with values** and **displaying all of them at once**. However the Office views the prior art's teaching of one modifying components associated with a value sufficient for one having ordinary skill in elementary math to include other mathematical operations that require values. Thus the Examiner views the alteration of having and **displaying each modifying component associated with a value** as yielding predictable results of known components under KSR. Furthermore the Office views the limitation of **displaying all of the component number modifiers** as a simple substitution of a known element yielding a predictable result under KSR. The prior art and the claimed invention both teach offering no control to the player in determining the component modifier. Thus the displaying of all possible modifiers only identifies the consequences of rejecting an award to the player; while the prior art chooses to surprise the player with the selected modifier. Thus substituting concealed modifiers for revealed modifiers yields a predictable result.

4. Regarding claim 2, 11, 19, 30, 38, 49, 61 and 65, figure 8 of the prior art demonstrates the occurrence of an event that allows the player to **accept** [keep] (fig. 8, 166) or **reject** [modify] (fig. 8, 164) an offer provided by the preferred embodiment (par. 19, lines 2-5).

5. Regarding claims 3-4, 12, 20-21, 31, 39-40 and 50-51, in one of the preferred embodiments the game displays three **masked** numbers (Fig. 3B, 116) (par. 56, lines 6-8) or **offer components** since each one is a piece of a final offer. A player is allowed to decide how to organize the pieces or components by selecting or activating a masked number's digit location.

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6. Regarding claims 6-8, 14-16, 23-25, 33-35, 42-44 and 53-55, the prior art illustrates in figure 5 that a **probability is associated with each offer component** or masked number and is stored in a database (par. 77, lines 1-2). The numbers are all weighted differently and the game machine is programmed to assign 50% of the time 0-3 as an offer component (par. 78). Therefore a player is more likely to receive an award of lower value thus **less likely to receive a greater award**.

7. Regarding claim 9, 17, 26, 36 and 45, the game machine offers awards associated with each offer component and the total **range of possible awards** is equal to $^{10}P_3 = 720$.

8. Regarding claims 27-28, the prior art discloses a **selector** or modify **button** that selects from several modification methods when a player rejects an award (par. 19, lines 2-5).

9. Regarding claim 46, the art discloses several possible modifiers that the game can select from and each possible modifier has a value or effect attributed to each one. As stated above, addition and multiplication always have positive effects, regeneration and scrambling are considered to have neutral effects since a player cannot allow depend on positive results and subtraction of a digit always has negative effects. Therefore the prior art discloses a game **selecting a modifier from a range of effects** or values.

10. Regarding claim 47, the prior art claims that each possible modifier is **selected based on a probability stored in a memory device** (par. 112, 119, 124, 129, 134, lines 1-3).

11. Regarding claims 59-60 and 63-64, the art discloses a modification that subtracts a digit, in other words unselects a number or offer component based on the number or value of the component (par. 22, lines 5-7). Since the value of an award is always lowered this **modifier is associated with a negative value** or effect and is considered very undesirable (par. 130, lines 6-10). Fortunately, the modifier **deselects the number** of the lowest value (par. 22, lines 5-7); therefore the offer component that contains the lowest number is associated with the negative value attributed to this modification.

Response to Arguments

Applicant's arguments filed 4/24/09 have been fully considered but they are not persuasive.

Summation

After the selection of the player's digits, the game will offer the player an award consisting of three digits by summing the activated components. In other words, the selection of the ten's digit yields 5, hundred's yields 1, one's yields 6; thus creating an award valued at 156 (100+50+6) which is one of the many possible awards.

Component Number Modifier

The multiply modifier of the prior art teaches displaying a number associated with a component modifier. Therefore the alteration of including a number with each component modifier will yield a predictable result from a known feature. Thus the obvious nature of this limitation prevents patentability under KSR.

Displayed Component Number

The Office views the limitation of **displaying all of the component number modifiers** as a simple substitution of a known element yielding a predictable result under KSR. In other words, substituting concealed modifiers for revealed the modifiers yields a predictable result, full disclosure of the consequence.

Previous Arguments

Applicant's arguments filed on 6/25/08 have been fully considered but they are not persuasive. The amendments made to the claims were addressed in the Office Action, please see above. The applicant argues the importance in showing the possible component number modifiers in a player deciding to risk an offer. The Examiner has already previously acknowledged the psychological effects of display or not displaying the modification methods as invoking the same sense of suspense towards the possibility of obtaining a higher offer. Furthermore the Examiner sees no patentable

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weight in displaying all of the component modifiers since it is an obvious alteration. Regarding the Applicant's request for suggestions or identifying patentable subject matter, the Examiner has nothing to offer towards both requests. One final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaching the gameplay methodology of the applicant's limitations when asking the Examiner to identify any allowable subject matter. Therefore it is possible for the applicant to disagree with this statement since these current arguments are made by Mr. Masia.

Examiner's Note

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims is patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTIAN E. RENDÓN whose telephone number is (571)272-3117. The examiner can normally be reached on 9 - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dimtry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

/CHRISTIAN E RENDÓN/
Examiner Art Unit 3714
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